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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,568

09/10/2003

Zheng Chen

MS1-1524US

4683

22801 7590 12/24/2008
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EXAMINER

RUTLEDGE, AMELIA L

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

12/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/659,568	Applicant(s) CHEN ET AL.	
	Examiner AMELIA RUTLEDGE	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9,11-14,16-28 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4,6-9,11-14,16-22 and 33-35 is/are allowed.
- 6) ☒ Claim(s) 23-28,30-32 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the following communications: Amendment, filed 12/04/2008; Request for Continued Examination, filed 12/04/2008; Amendment to Specification, filed 12/04/2008.
2. Claims 1-4, 6-9, 11-14, 16-28, and 30-36 are pending. Claims 1, 14, and 23 are independent claims.
3. Applicant's amendment to the Specification filed 12/04/2008, replacing the paragraph beginning at page 7, line 4, has been received and entered in the application file.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/04/2008 has been entered.

Allowable Subject Matter

Claims 1-4, 6-9, 11-14, 16-22, and 33-35 are allowed.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Independent claim 23 has been amended to add the newly claimed limitations, *One or more computer-readable media having computer-executable instructions embodied on at least one tangible component of the computer-readable media, the computer-executable instructions when executed on a computer, cause the computer to perform steps comprising....*(see lines 1-4).

The specification fails to provide proper antecedent basis for the claimed subject matter, "one tangible component of the computer-readable media". The meaning of the term "tangible component" is not clearly ascertainable by reference to the specification.

37 CFR 1.75(d)(1) provides that "The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-28, 30-32, and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claim 23, claim 23 has been amended to add the newly claimed limitations, *One or more computer-readable media having computer-executable instructions embodied on at least one tangible component of the computer-readable media, the computer-executable instructions when executed on a computer, cause the computer to perform steps comprising....*(see lines 1-4).

Applicant's amendment to the paragraph of the specification, beginning at page 7, line 4, filed 12/04/2008, defines "computer-readable media" as "...computer readable media identified as communication media. Communication media typically embodies computer readable instructions, data structures, program modules, or other data in an information delivery media." The definition of "computer readable media" provided by the specification defines the claimed "computer readable media" as failing to be limited to embodiments which fall within a statutory category of invention under 35 USC 101.

Applicant has not provided an explicit and deliberate (i.e., limiting) definition of the claim terminology "computer-readable media", but applicant has provided intrinsic evidence of the embodiments intended to be covered within the meaning. The covered embodiments include "computer readable instructions, data structures", and "program modules". The covered embodiments, at best, are directed to software *per se*, and fail to fall within a statutory category of invention.

While claim 23 also recites, ... *the computer-executable instructions when executed on a computer, cause the computer to perform steps comprising...*, claim 23 is

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directed to the instructions themselves (and to non-statutory computer-readable media), and are not directed to a process, machine, manufacture, or composition of matter, because the phrase "*when executed on a computer*" does not limit the claim to a machine programmed to operate in accordance with the instructions, nor a manufacture structurally and functionally interconnected with the instructions in a manner which enables the instructions to act as a computer component and realize their functionality.

Regarding dependent claims 24-28, 30-32, and 36, claims 24-28, 30-32, and 36 are rejected because they add no limitations which would render the claimed subject matter statutory under 35 USC 101.

Response to Arguments

Applicant's arguments filed 12/04/2008 have been fully considered but they are not persuasive.

Regarding the request of applicant's representative for an interview, see Remarks, p. 20, an interview was held with applicant's representative on 11/18/2008 to discuss possible ways the claims or specification could be amended to overcome the rejections under 35 USC 101, see Interview Summary mailed 11/20/2008.

Suggested ways of overcoming the rejections under 35 USC 101 include:

1) removing the portion of the specification defining "computer readable media" as being directed to non-statutory subject matter (see paragraph of specification beginning at page 7, line 4);

2) limiting the claimed "computer readable media" in the specification to fall under a statutory category of invention; or

3) limiting the claim terminology to tie the claimed invention to an element of computer hardware disclosed in the specification.

The claim amendments and amendment to the specification filed 12/04/2008 are not sufficient to overcome the rejections under 35 USC 101. For the reasons set forth in the rejections of claims 23-28, 30-32, and 36, above, and in the objection to the specification, above, claims 23-28, 30-32, and 36 are non-statutory under 35 USC 101.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMELIA RUTLEDGE whose telephone number is (571)272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amelia Rutledge/
Examiner, Art Unit 2176